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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,498	11/21/2001	Yue Ma	9432-000145	3411

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EXAMINER

LIU, MING HUN

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/990,498

Applicant(s)

MA ET AL.

Examiner

Ming-Hun Liu

Art Unit

2675

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 June 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


DENNIS-DOON CHOW
PRIMARY EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because: The applicant's request for the withdrawal of the finality of the rejection has been denied. The applicant amended the claim in the previous office action therefore changing the scope and bound of the particular claim. Once the scope of the claim in question is changed due to any amendment, the examiner has the right to change the ground of rejection.

In response to arguments concerning the rejection of claim 1, the examiner agrees with the applicant's assertion in paragraph 1, page 18 that Carau's invention differs from the claimed invention. The examiner recognizes Carau's inadequacy in addressing all the limitations of the claimed invention, which is why the Weber reference was called upon. Carau's reference is being used as an example of whiteboard with memory capabilities. With that foundation the Weber reference was added to include the innovation of storing a plurality of images as suggested by Weber. As for the applicant's argument concerning Weber's inadequacy in "labeling data with headers while the image is on a single cell whiteboard and simultaneously creating an indexing system" (page 14, 2nd paragraph), such an argument cannot be applied because the claim simply does not include such limitations. Therefore the argument is considered moot since the claim is only limiting the invention to a "header [is] based at least in part on a selected portion of the user-drawn marks selected by the user" a limitation anticipated by Weber. The applicant is arguing the claim in light of the information disclosed in the applicant's specifications and not the claims. Lastly, the applicant is arguing the references independently. However, one cannot show non-obviousness by attacking references individually where as the rejection is based on the combination of references. In re Keller, 208 USPQ 871 (CCPA 1981).

In response to applicant's arguments concerning the rejection of claims 7 and 8, the applicant is arguing the references independently. However, one cannot show non-obviousness by attacking references individually where as the rejection is based on the combination of references. In re Keller, 208 USPQ 871 (CCPA 1981). The motivation to combine the references were outlined in the final rejection and the examiner will maintain the ground of rejection.

In response to applicant's arguments concerning the rejection of claims 13 and 14, the claims fail to explicitly distinguish the requirement of being able to extract open circles. The applicant is arguing the claim according to support disclosed in the applicant's specifications and not the claims.